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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,634	12/04/2000	Douglas J. Woodnorth	08935-226001 / M-4934	3041

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BOSTON, MA 02110

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/729,634

Applicant(s)

WOODNORTH, DOUGLAS J.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 32-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. **Claims 1-31 and 41-43**, drawn to method and apparatus for monitoring battery usage, and for billing consumers for said battery usage, class 705, subclass 400.
- B. **Claims 32-36**, drawn to a battery dispensing vending apparatus, class 221, subclass 135.
- C. **Claims 37-40**, drawn to a battery charging apparatus, class 320, subclass 107.

Inventions A, B and C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention A has utility separate from that of inventions B and C, such as leasing communication equipment; and invention B has utility separate from that of inventions A and C, such as digital camera dispensing apparatus. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

During a telephone conversation with Applicant's representative on March 5, 2003 a provisional election was made without traverse to prosecute the invention of A, **claims 1-26 and 41-43**. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 32-40 are withdrawn from further consideration by the examiner, 37 FR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 1-13, 15-16, 22 and 25 are objected to because of the following informalities:

Claims 1-13, 15-16, 22. Examiner believes that the phrase “communicating battery usage to a remote monitor” should be presented as “communicating battery usage *information* to a remote monitor”. Appropriate correction is required.

Claim 25. The term “capable” indicates the potential capability, but not intentional functionality. Examiner suggests to change the phrase “capable of” to “for”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 8 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8. The claim is confusing, because it is not clear what exactly is provided without a purchasing fee: a battery (regardless purchasing fee for a device), or the device and the battery, both being free of charge.

Claim 14. The term “OR” makes the claim indefinite, because it is not clear what does the term “usage” define: the usage of energy consumed (battery), or services rendered by the device (for example usage of a cell phone).

Claims 15-20 are rejected as being dependent on **claim 14**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 4-5, 7-8, 11, 13-15, 17-19, 21-23, 25-26 and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta (US 5,349,535).

Gupta teaches a vehicle battery condition monitoring and recording method and system, comprising:

Independent Claims:

Claim 1. Providing a battery to a user to be installed in user's car; communicating battery usage to a remote monitor (column 10, lines 28-34).

Claim 14. Determining the usage of the battery, determining a fee based on the usage (column 3, lines 47-50).

Claim 21. A battery including a CPU for storing vehicle ID number, with which the battery is associated, and historical usage data (column 7, lines 32-34; column 8, lines 38-51).

Claim 41. An external monitor comprising: a communication module adapted to receive a communication of battery identification and/or usage; an account storage module to store the identification and usage information; and a billing module to initiate billing based on the identification and usage information (column 10, lines 28-35).

Claim 42. See claim 41.

Claim 43. See claim 41.

Dependent Claims:

Claim 4. See claim 14.

Claim 5. See claim 14.

Claim 7. Providing the customer with option to purchase the battery, or to lease it (leasing option inherently indicates absence of purchase fee) (column 3, lines 29-30).

Claim 8. See claim 7.

Claim 11. See claim 1.

Claim 13. Said method and system, wherein the battery usage is based on recharge cycles (column 7, lines 31-36, 42-43, 48-49).

Claim 15. See claim 14.

Claim 17. See claim 14.

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Claim 18. Providing a plurality of charging stations, where the fee for replacement or recharging is based on the usage and/or said terms (column 9, lines 55-58; column 11, lines 30-45).

Claim 19. See claim 1.

Claim 22. Said method and system, including a communication device (CPU) facilitating communication of usage to an external device (column 6, lines 44-47).

Claim 23. Said method and system, including a battery device detector that detects the device in which the battery is installed (column 9, lines 25-27).

Claim 25. A disabler capable of disabling battery use (column 7, lines 14-16).

Claim 26. See claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta.

Independent Claim:

Claim 27. Gupta teaches a battery having attached thereto an electrically readable module having memory for storing data (column 6, lines 44-61).

Gupta does not specifically teach that said data includes representation of battery acquisition and/or recharge terms.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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Dependent Claim:

Claim 20. Gupta teaches all the limitations of **claim 20**, except specifically teaching that said battery is a single use battery.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claims 2-3, 6, 9-10, 16 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Thandiwe (US 6,456,036).

Dependent Claims:

Claim 2. Gupta teaches all the limitations of **claim 2**, including communicating the usage information by transmitting a signal representative of the battery usage over the network (column 10, lines 31-32), except specifically teaching that said network is the Internet.

Thandiwe teaches a method and system for a battery having a network communication interface, including communicating the usage information over the Internet, wherein said communication is provided by wireless communication means (column 2, lines 14-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include that said network is the Internet, because it would make the information instantly available at any remote location adapted to be connected to the Internet, thereby make it more attractive to users.

Claim 3. See **claim 2**.

Claim 6. See **claim 2**.

Claim 9. Thandiwe teaches said method and system, wherein the device is a communication device (column 2, lines 16-17).

Claim 10. Thandiwe teaches said method and system, wherein the usage information is communicated by the device (column 2, lines 16-17).

Claim 16. See claim 2.

Claim 28. See claim 21.

Claim 29. See claim 22.

Claim 30. See claim 21.

Claim 31. See claim 1.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Fischl et al. (US 5,293,109).

Dependent Claim:

Claim 24. Gupta teaches all the limitations of claim 24, except for providing a mechanism for verifying the installed device as a permissible device.

Fischl et al. teach a method and system for early recognition battery disconnect, comprising means for determining if the appropriate battery is attached to a device. If the determination is negative, the device is prevented from powering up (column 3, line 60 – column 4, line2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include means for verifying the compatibility of the battery and the installed device, because it would prevent damage of said device if the voltage or current in the battery is too high for the device, as specifically taught by Fischl et al. (column 3, lines 67-68).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

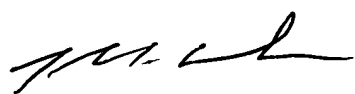
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB


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